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10/775,077	02/11/2004	Daniel Roux		3419

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EXAMINER

POUS, NATALIE R

ART UNIT	PAPER NUMBER
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3731

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/775,077	Applicant(s) ROUX ET AL.	
	Examiner Natalie Pous	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 9,10,12-14,16-21 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,11,15,22,23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Regarding the Specification

Examiner acknowledges correction to the abstract to overcome the previous objection, thus the objection to the abstract is withdrawn.

Regarding Porter

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection based on amendments to the claim.

Election/Restrictions

Newly submitted claims 9, 10, 12-14, 16- 21 and 24-26 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

This application contains claims directed to the following patentably distinct species:

Species 1: fig. 1

Species 2: fig. 2

Species 3: fig. 3

Species 4: fig. 4

Species 5: figs. 5a-5l

Species 6: figs. 6a-6b

Species 7: figs. 7a-7c

Species 8: figs. 8a-8b

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Species 9: figs. 9a-9b

Species 10: figs. 10a-10d

Species 11: figs. 11a-11e

The species are independent or distinct because they require different technical features. For instance, species 7 requires a suction skirt not required by other species, and species 3 requires actuating cables not required by other species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 4 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

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requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9, 10, 12-14, 16- 21 and 24-26 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1-8, 15 & 22 are
Claims 1-8, 15 & 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ngo (US 4467803). Ngo teaches a hemostatic tissue clamp (fig. 1) for clamping a target tissue site, said tissue clamp comprising: a first jaw member (7) and a second jaw member (8), said first and second jaw members being movable between an open configuration (fig. 1) and a clamping configuration, wherein when said first and second jaw members are in said open configuration said first and second jaw members are in a substantially spaced relationship relative to each other for allowing insertion of at least a portion of said target tissue site therebetween (fig. 1), and wherein when said jaw members are in said clamping configuration said first and second jaw are in a substantially proximal relationship relative to each other for exerting a hemostatic pressure on said portion of said target tissue site (fig. 10); said first and second jaw members together defining a substantially uninterrupted tissue contacting surface when said jaw members are in said open configuration (fig. 1), said tissue contacting surface configured and sized for exerting a hemostatic pressure substantially encompassing said inserted portion of said target tissue when said jaw members are in said clamping configuration (fig. 7); a jaw actuating means (10) mechanically coupled to said first and second jaw members for

actuating said first and second jaw members between said open and clamping configurations.

Regarding Claim 2, Ngo teaches the hemostatic tissue clamp of claim 1, wherein each of said first and second jaw members is configured with a substantially arcuate profile (fig. 1), said jaw members being sized to encompass said inserted portion of target tissue site within said arcuate profile when said jaw members are in said closed configuration (fig. 10), said jaw members being pivotally moveable between said open and closed configurations about a pivotal axis, each of said first and second jaw members terminating at a pair of jaw ends being spaced apart along said pivotal axis and generally aligned thereto.

Regarding Claim 3, Ngo teaches the hemostatic tissue clamp of claim 2, wherein said jaw actuating member includes two pairs of jaw actuating arms (7, 8), each of said first and second jaw members being connected to both said pairs of jaw actuating arms (fig. 1), said first and second jaw members being actuated between said open and clamping configurations by the simultaneous application of a scissor-type movement to each of said pairs of jaw actuating arms.

Regarding Claim 4, Ngo teaches a tissue clamp for clamping a body tissue, said body tissue including a target tissue and a non-target tissue, said target tissue being separated from said non-target tissue by a peripheral border, said tissue clamp comprising:

a first jaw member and a second jaw member, said first and second jaw members each having first and second jaw ends, said first and second jaw members being coupled to

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each other at a first coupling member at respective said first jaw ends and simultaneously coupled to each other at a second coupling member at respective said second jaw ends, said second coupling member being spaced apart from said first coupling member (fig. 1);

- said first and second jaw members being movable between an open configuration and a clamping configuration, wherein when said jaw members are in said open configuration said jaw members are in a substantially spaced relationship relative to each other for allowing insertion of said target tissue there between (fig. 1), and wherein when said jaw members are in said clamping configuration said first and second jaw are in a substantially proximal relationship relative to each other for exerting a tissue clamping pressure substantially adjacent to said target tissue (fig. 10);

- said first and second Jaw members together defining a substantially continuous jaw perimeter when said jaw members are in said open configuration, said jaw perimeter being configured and sized with a tissue contacting surface for exerting said tissue clamping pressure generally along said peripheral border so as to substantially encompass said target tissue from said non-target tissue when said jaw members are in said clamping configuration (fig. 1);

a jaw actuating member (13) mechanically coupled to said first and second jaw members for actuating said first and second jaw members between said open and clamping configurations.

Regarding Claim 5; Ngo teaches the tissue clamp of claim 4, wherein said first and second coupling members are configured to allow relative pivotal movement

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between said first and second jaw members when said jaw members are actuated between said closed and open configurations, said pivotal movement occurring about a pivotal axis generally aligned through said first and second coupling members (fig. 1).

Regarding Claim 6, Ngo teaches the tissue clamp of claim 5, wherein said first coupling member includes a first hinge member and said second coupling member includes a second hinge member, said pivotal axis extending through said first and second hinge members, and wherein each of said first and second jaw members is configured with a substantially arcuate jaw profile, said jaw members being sized to encompass said target tissue within said arcuate jaw profile when said jaw members are in said closed configuration, each of said arcuate jaw profiles extending between a first and a second arc end, said first and second arc ends of each of said arcuate jaw profiles being located generally adjacent to said first and second hinge members, respectively (fig. 1).

Regarding Claim 7, Ngo teaches the tissue clamp of claim 5, wherein said tissue clamp further comprises a clamp locking member (10) for releasably locking said first and second jaw members in a predetermined spatial relationship relative to each other.

Regarding Claim 8, Ngo teaches the tissue clamp of claim 4, wherein said jaw actuating member is displaceable in a direction extending laterally away from said target tissue so as to reduce obstruction to said target tissue when said jaw members are in said clamping configuration (fig. 1).

Regarding Claim 15, Ngo teaches the tissue clamp of claim 4, wherein said tissue clamp further comprises a clamp attachment member (13, it is noted that any portion of the device may be used to attach the device to a surgical platform) for attaching said

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tissue clamp to a surgical platform so as to allow setting of said first and second jaw members in a desired spatial relationship relative to said surgical platform.

Regarding Claim 22, Ngo teaches the tissue clamp of claim 4, wherein said first and second jaw members are configurable to vary the shape and size of said continuous jaw perimeter so as to allow improved conformance of said tissue contacting surface to said peripheral boundary and so as to encompass various shapes or sizes of said target tissue (Column 3, proximate lines 2-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo in view of Smith, III (US 4817604)

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Ngo teaches all limitations of preceding dependent claim 4, but fails to teach wherein said tissue contacting surface of said jaw perimeter includes a friction-enhancing texture. Teaches a tissue gripping device, wherein the gripping surfaces comprise friction-enhancing texture in order to firmly grip the tissue there between. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Ngo with friction enhancing texture as taught by Smith III in order to firmly grip tissue between the two gripping members.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ngo. Ngo teaches all limitations of preceding dependent claims 5 and 4, but fails to teach wherein said tissue clamp is configured and sized for use in a nephron-sparing surgery, said body tissue being a kidney, said target tissue including a tumourous mass on said kidney, said first and second jaw members providing hemostatic damping of said target tissue so as to allow surgical treatment of said tumourous mass without exposing said non-target tissue of said kidney to hemostasis. It would have been an obvious matter of design choice to disclose the device of Ngo as being sized for use in nephron-sparing surgery, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose 105 USPQ 237 (CCPA 1955).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie Pous whose telephone number is (571) 272-6140. The examiner can normally be reached on Monday-Friday 8:00am-5:30pm, off every 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tan-Uyen (Jackie) Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NRP
5/10/07


(JACKIE) TAN-LYEN HO
PRIMARY EXAMINER
5/11/07